

REMARKS

The restriction/election of species requirement is traversed on the grounds that assertions that the inventions of Groups I-III (formulations) and Groups IV-VI (method of preventing, controlling and eliminating parasites) are distinct. However, a restriction/election of species requirement must also indicate why the inclusion of multiple invention represents a burden to the office (see MPEP 803 - "If the search and examination of an entire application can be made without serious burden, *the examiner must examine it on the merits*, even though it includes claims to independent or distinct inventions.>").

Given that the method of use claims use the same or substantially similar formulations claimed in Group I, the same search used for the claims of Group I would also be used in the search for the method of use claims of Group IV-VI. In addition, there is no indication from the Image File Wrapper that even a cursory search of the prior art has been made and as such any assertion of undue burden is purely speculative. Therefore, there is no basis which supports that it would be an undue burden on the office to examine the claims of Groups IV-VI.

Even if additional support for an undue burden was later presented and this restriction/election of species is maintained, the applicants note the method of use claims 29-43 are directly or indirectly linked to claim 1. MPEP 809.03 "Linking Claims" states: "The most common types of linking claims which, if allowed, act to prevent restriction between inventions that can otherwise be shown to be divisible, are

- (A) genus claims linking species claims;
- (B) a claim to the necessary process of making a product linking proper process and product claims;
- (C) a claim to "means" for practicing a process linking proper apparatus and process claims; and
- (D) **a claim to the product linking a process of making and a use (process of using).**"

Type (D) most closely resembles the claims of the invention. As such, the Examiner is reminded that MPEP 809 states in part that "[t]he *linking claims must be examined with the invention elected*, and should any linking claim be allowed, the restriction requirement must be withdrawn." (emphasis added)

Method of use claims 44 and 45 are not directly linked to the formulation claims, but the description of the formulation is substantially similar to formulation claim 1.

Lastly, MPEP 821.04 (Rejoinder) states in part that “Where product and process claims drawn to independent and distinct inventions are presented in the same application, applicant may be called under 35 U.S.C. 121 to elect claims to either the product or the process. See MPEP § 806.05(f) and § 806.05(h). The claims directed to the nonelected invention will be withdrawn from further consideration under 37 CFR 1.142. See MPEP § 809.02(c) and § 821 through § 821.03. *However, if an applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims which depend from or otherwise include all the limitations of the allowable product claim will be rejoined.*” (italics added)

In summary, the claims of Groups IV-VI have not been shown to represent an undue burden on the Office, the claims of Groups I-III and Groups IV-V are linked and the claims of Groups IV-VI would be rejoined with the claims of Groups I when the latter claims are allowed. For any of these reasons, the restriction/election of species requirement should be withdrawn and all the claims should be examined on the merits.

[Note: A preliminary amendment is being filed concurrently with this response to correct minor errors to the claims which were discovered when reviewing the claims as published in U.S. Patent Application Publication 2005-0137244]

CONCLUSION

In view of the above, reconsideration and withdrawal of the restriction requirement is respectfully requested. Early and favorable consideration of the application on the merits, and early Allowance are earnestly solicited.

The Commissioner is hereby authorized to charge any additional fee which may be required, or credit any overpayment to Account No. 50-0320.

Respectfully submitted,
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